

Remarks

Claims 1-5, 7-9, 11-13, 15-23, 30, 50, 51, 55, 58-61, 64, 67-86, 88, 92, and 94 are pending. Claims 3, 16, 18, 20, 22, 50, 51, 55, 58-61, 64, and 67-85 have been withdrawn. Therefore, claims 1, 2, 4, 5, 7-9, 11-13, 15, 17, 19, 21, 23, 30, 86, 88, 92, and 94 are under consideration. Claims 9 and 13 have been amended to correct dependencies. No new matter is believed to be added by these amendments. Moreover, these amendments are believed to raise no new issues.

35 USC § 112, second paragraph

Claims 9 and 13 are rejected under 35 USC § 112, second paragraph as allegedly being indefinite. In particular the Examiner asserts that there is no antecedent basis for the recitation “the transcription factor ER” in claims 9 and 13. Applicants have amended claims 9 and 13 to correct their dependency to claims 8 and 12, respectively. This rejection is believed to be overcome in light of Applicants’ amendments and it is respectfully requested that the rejection be withdrawn.

35 USC § 102

Claims 1, 2, 4, 5, 7-9, 11-13, 15, 17, 19, 21, 23, 30, 86, 88, 92, and 94 are rejected under 35 USC § 102(b) as allegedly being anticipated by Muyan *et al* (2001) *Mol. and Cell Endocrinol.* 182: 249-263. Applicants remind the Examiner that in order for a reference to anticipate a claim, each and every element of the claim must be taught in the cited art. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully point out that claim Claim 1 recites “A composition comprising the formula W-Z-X, wherein W comprises a first DNA binding domain, X comprises a second DNA binding domain and Z comprises a hinge domain.” Applicants respectfully point out that Muyan *et al* does not teach or disclose this feature. In particular, Applicants point out that Figure 1A of Muyan *et al* discloses the fusions disclosed therein are composed of two entire estrogen receptors. Applicants respectfully point out that such a construct necessarily includes ALL of the domains of the receptors (see page 251, column 1, second paragraph and Figure 1A which shows that a single fusion was made by

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annealing one receptor at codon 595 to a second receptor at codon 1). Thus, the dimers of Muyan et al contain not only the DNA binding domains and hinge domains, but also contain the A/B transactivation domain and the E/F domains. As shown in Figure 1A this would mean that there is a DNA binding domain (C) followed by a hinge domain (D) then a E and F domains before being linked to an A/B domain and then finally to a second DNA binding domain. This is important because, as the Examiner is no doubt aware, “claim interpretation is made in light of the specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Applicants describe what is meant by W-Z-X in the specification. In particular, on page 28, line 8 through page 29, line 7, Applicants describe that “one way of representing linked modulator is by using the formula W-Z-X.” see page 28, line 17. Applicants then note on page 29 that for “linked modulators which are based on the ER, it is understood that ...for ER based linked modulators, a linked modulator could be CDC. Importantly, CDC is not what is disclosed in Muayn et al. Instead, Muyan discloses CDEFABC given the reading most favorable to the Examiner. Thus, as disclosed in Muyan and defined in the specification, such a construct does not comprise the formula W-Z-X as is claimed. Because Muyan et al does not disclose any construct comprising the formula W-Z-X as defined in the specification and required by the claim, Muyan et al does not teach each and every limitation of the claim. Therefore, Muyan et al does not anticipate the present claims. Applicants believe this rejection has been overcome and respectfully request its withdrawal.

Pursuant to the above amendments and remarks, reconsideration and allowance of the pending application is believed to be warranted. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of this application to issue.

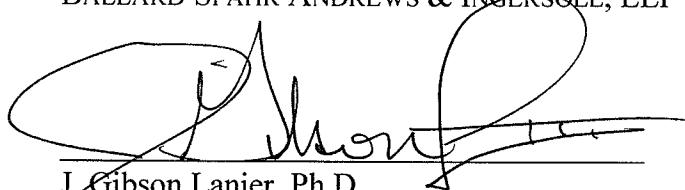
A credit card payment in the amount of \$555.00 is being submitted electronically, representing the small entity fee for a three (3) month Extension of Time under 37 C.F.R. § 1.17(a)(3) and a Request for a three (3) month Extension of Time are enclosed. This amount is

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believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF ELECTRONIC TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted via electronic transmission via EFS-Web on the date indicated below.

Name of Person Mailing (Print/Type)	J. Gibson Lanier	Date	10/3/08
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